

REMARKS

Claims 116-121, 123, and 125-147 remain pending in this application. Claims 116, 128, 129, 139, 140 and 147 have been amended. Further reconsideration of this application is requested.

Finality of Rejection

The finality of the outstanding Office action is premature because of the new grounds of rejection not necessitated by any amendment to the claims. In particular, the new grounds of rejection of claims 139 and 147 under the second and fourth paragraphs of 35 U.S.C. § 112 and under 35 U.S.C. § 101 could not have been necessitated by the February 25, 2002 response because claims 139 and 147 were not amended in that response. Accordingly, the finality of the outstanding Office action should be withdrawn. See MPEP § 706.07(a) (second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement).

Previous Grounds of Rejection

The Office action asserts that the February 25, 2002 amendment "is ineffective to overcome the Ausubel (5,905,975) and Thiessen (5,495,412) references." However, 37 CFR § 1.113(b) requires that a final rejection repeat or state all grounds of rejection then considered applicable to the claims in the application. See also MPEP § 706.07, which states that any such grounds of rejection in a final rejection should be reiterated, and provides that the final rejection include a rebuttal of any arguments raised in the applicant's reply.

Because the outstanding Office action has neither reiterated the prior grounds of rejection based on Ausubel and Thiessen, nor rebutted any of applicants' arguments raised in the February 25, 2002 response, the prior grounds of rejection stand withdrawn on the record.

35 U.S.C. § 112 Rejections

The rejection of claims 139 and 147 under the second and fourth paragraphs of 35 U.S.C. § 112 is traversed to the extent that this ground of rejection may be applied to claims 128, 139 and 147 as amended. These claims are properly directed to a computer-readable medium having stored therein computer-executable instructions for causing a computer to perform a series of steps as specified in another claim. Contrary to the position of the Office action, claims 128, 139 and 147 are in full compliance with the fourth paragraph of 35 U.S.C. § 112, in that the claims incorporate by reference all the limitations of the claims to which they refer, and specify further limitations of the subject matter being claimed by requiring that the method steps be stored as computer-executable instructions in a computer-readable medium.

The fourth paragraph of 35 U.S.C. § 112 does not require that a claim dependent from an apparatus claim contain a structural limitation, or that a claim dependent from a method claim contain a process limitation, but rather that the claim specify a further limitation of the subject matter claimed. In this regard, a dependent and independent claim need not necessarily fall within the same statutory class of subject matter. See MPEP § 608.01(n) at 600-77 (8th Edition, 2001). The purpose of the fourth paragraph of § 112 is to prohibit a dependent claim from eliminating or modifying limitations set forth in a previous claim, not to dictate the nature of the further limitations to the subject matter claimed. See Ex parte Porter, 25 USPQ2d 1144, 1147 (BPAI 1992) (a claim is in compliance with the fourth paragraph of 35 U.S.C. § 112 if it incorporates by reference all of the subject matter of another claim, and is not broader than such claim in any respect).

35 U.S.C. § 101 Rejection

The rejection of claims 139 and 147 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is traversed. These claims are directed to a computer-readable medium containing computer-executable instructions which cause a programmable computer to perform the functions specified by the instructions, and as such constitute a useful article of manufacture under § 101. The claims do not embrace two different statutory classes of invention merely by referring to the method

steps that the computer is caused to perform when the computer-executable instructions are read into the computer from the computer-readable medium, as set forth in another claim. Ex parte Lyell, 17 USPQ2d 1548 (BPAI 1990) is distinguishable and is inapplicable to the present facts because it involved construction of an independent claim that by its literal terms purported to be “[a]n automatic transmission tool in the form of a workstand and method for using same.” The claim thus purported to claim both an apparatus and a method of using the apparatus in a single claim. Id., 17 USPQ at 1549.

Here, claims 139 and 147 claim a computer-readable medium, not a computer-readable medium and method of using the computer-readable medium. As the Board of Patent Appeals and Interferences explained in Ex parte Porter, each of claims 139 and 147 “could be construed as an independent claim, drafted in a short-hand format to avoid rewriting the particulars of the [method] recited in [claims 129 and 140].” 25 USPQ2d at 1147.

Because neither claim 139 nor claim 147 purports to claim more than one statutory category of subject matter, these claims do not violate 35 U.S.C. § 101, and this ground of rejection should be withdrawn.

35 U.S.C. 102 Rejection

The rejection of claims 116-120, 123, 127-129, 133, 135, 137, 139-143, and 145-147 under 35 U.S.C. § 102(e) as being anticipated by newly cited U.S. Patent No. 5,924,082 to Silverman et al. (“Silverman”), is respectfully traversed.

Silverman discloses a matching system for identifying potential counterparties to a transaction based on users’ ranking of other users of the system. The Silverman system pertains to specialized transactions in which traders use subjective criteria such as the party’s credit rating, geographic location, political affiliation, or other subjective criteria, to filter out unacceptable trading parties. The users of the system enter subjective ranking information for all other users, who are identified to each user in a display (see Fig. 3). A user then enters bid/offer information together with minimum rank information (see 507, Fig. 5B) that represents the lowest rank of any potentially acceptable counterparty to the transaction entered by the user.

The matching computer then matches bids and offers entered based on the bid/offer parameters and the ranking information. Once potential matches are identified, the matching computer signals the potential counterparties, by opening a window in each counterparty's computer display (similar to Internet "instant messaging" windows), to enable the parties to communicate with each to commence direct negotiations. See col. 12, ll. 18-21; 53-58. Once the parties agree, signals are sent from their remote terminals to the matching computer indicating that the parties have reached agreement, which thereby cause the matching computer to remove the bid and offer information from the system. See col. 7, ll. 54-63.

Contrary to the present invention as claimed, the Silverman system does not intermediate the exchange of commodities among plural parties through a series of offer and counter-offer messages from the participants to the intermediary and from the intermediary to the participants. Instead, the Silverman system merely identifies potential counterparties to a transaction and then brings the identified parties into contact with each other such that the parties negotiate the transaction directly. See col. 12, ll. 6-14; see also col. 6, ll. 39-45 and Fig. 2 which illustrates the direct connections between remote terminals (e.g., terminals 101 and 102) bypassing the matching computer 11, for direct communication during negotiations. As Silverman states, "[t]he system does not automatically execute transactions. Instead, the system introduces compatible counterparties who are provided with an opportunity to communicate with one another prior to execution of the transaction to negotiate some or all terms of the transaction." Col. 12, ll. 59-67.

Thus, contrary to the claimed method of intermediated exchange of commodities, Silverman merely discloses a financial "dating service" that introduces parties to each other based on profiles entered into the system by each user. Once the potentially matching counterparties are introduced to each other, the Silverman system has no further interaction with the parties except to receive a notice that the parties have agreed to transaction terms. Negotiations and completion of the transaction are left to be conducted directly by the parties. See col. 4, ll. 39-41; col. 7, ll. 50-53; col. 12, ll. 10-13; col. 12, ll. 63-67. One constraint of the Silverman system is that each user's identity must be disclosed to all other users for the matching system based on ranking to

function. To the contrary, the intermediated exchange method and system according to the present invention as set forth in the claims does not require party identification to any other party, and preferably consummates transactions anonymously.

In particular, Silverman fails to disclose generating electronic offer messages to the participants from the intermediary in response to received messages from said participants, wherein the electronic offer messages are determined by the intermediary based on said received messages; Silverman further fails to disclose generating electronic counter-offer messages from the participants to the intermediary in response to received electronic offer messages, whereby the substantially-satisfactory offered amounts as negotiated through the intermediary determine an exchange of a plurality of commodities among a plurality of participants, as set forth in claim 116.

Similarly, Silverman fails to disclose a computer implemented method for intermediating electronic exchange of a plurality of commodities among a plurality of participants as set forth in claim 129, wherein electronic opening and counter-offer messages are received from the participants, and electronic offer messages are generated and sent to the participants, whereby substantially-satisfactory offered amounts determine an intermediated exchange of a plurality of commodities among a plurality of participants.

Silverman further fails to disclose a computer implemented method for representing a participant in an intermediated exchange of commodities with at least one other participant as set forth in claim 140, wherein an electronic opening message is generated to an intermediary, an electronic offer message is received from the intermediary, and one or more electronic counter-offer messages are generated to the intermediary in response to electronic offer messages from the intermediary, whereby the substantially-satisfactory, offered amounts represent each participant's objectives in the intermediated exchange.

In view of the above, Silverman does not and cannot anticipate any of claims 116-120, 127-129, 133, 135, 137, 139-143 or 145-147 under 35 U.S.C. § 102 as a matter of law. Reconsideration and withdrawal of this ground of rejection is requested.

35 U.S.C. § 103 Rejections

Silverman similarly does not render obvious any of claims 121, 125, 126, 136 or 138 under 35 U.S.C. § 103. These claims include all of the limitations of the independent claims from which they depend, and as such are submitted to be allowable for the same reasons as discussed above.

The rejection of claims 130 and 144 under § 103 as being unpatentable over Silverman in view of Ausubel, and the rejection of claims 131, 132 and 134 as being unpatentable over Silverman in view of Thiessen, also are traversed. Ausubel and Thiessen were extensively discussed in the response filed February 25, 2002, wherein it was explained in detail why neither of those prior art references is relevant to the claimed invention. Those explanations are incorporated herein by reference in their entirety. No combination of Ausubel and/or Thiessen with Silverman would result in the invention of independent claims 116, 129 or 140. Consequently, claims 130-132, 134 and 144 are not rendered obvious by any combination of Silverman with Ausubel and/or Thiessen. Additionally, neither Thiessen nor Ausubel discloses any of the specific limitations of claims 130-132, 134 or 144. Reconsideration and withdrawal of this ground of rejection is requested.

Conclusion

In view of the foregoing, claims 116-121, 123 and 125-147 are respectfully submitted to define patentable subject matter, that is neither disclosed nor suggested by Silverman, Ausubel or Thiessen or any combination thereof. Further and favorable reconsideration of this application and the issuance of a Notice of Allowance are earnestly solicited. In the event that the Examiner remains unpersuaded of the allowability of the claims, he is requested to contact the undersigned to schedule a personal interview in an effort to resolve any remaining issues regarding the differences between the pending claims and the applied prior art.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17
to Deposit Account No. 02-2135.

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Attachments: Marked-Up Copies of Amendments

MARKED-UP COPY OF AMENDMENTS SHOWING CHANGES MADE

In the Claims:

--116. (Twice Amended) A computer implemented method for an electronic intermediated exchange of a plurality of commodities among a plurality of participants comprising the electronic negotiation steps of:

(a) generating electronic opening messages from the participants to the intermediary, wherein the opening messages comprise digital data representing opening requests of the participants to buy and/or to sell amounts of one or more commodities, and wherein, for at least one commodity both buy and sell requests are generated by participants;

(b) generating electronic offer messages to the participants from the intermediary in response to received [opening] messages from said participants, wherein the content of the electronic offer messages are determined by the intermediary based on said received messages and comprise digital data representing offers to the participants respectively to buy and/or to sell amounts of one or more commodities requested in said opening messages by said participants respectively to be sold and/or bought, with each offer being less than or equal to the amounts represented in the corresponding opening request, and wherein, for at least one commodity, the offer messages comprise both buy and sell offers, and wherein, for said at least one commodity, the total of the amounts offered for sale in all the generated offer messages equals the total of the amounts offered for purchase in all the generated offer messages,

(c) generating electronic counter-offer messages from the participants to the intermediary in response to received electronic offer messages, wherein the electronic counter-offer messages comprise digital data representing further requests to buy and/or to sell amounts of one or more commodities with each further request being less than or equal to the amounts represented in the corresponding opening request, wherein, for at least one commodity, the counter-offer messages comprise both buy and sell requests; and

(d) repeating steps (b) and (c), if necessary, until the last offer message to each participant from the intermediary is indicated in a [further] responsive message to the intermediary from that participant to represent offered amounts of one or more

commodities to buy and/or to sell in the exchange that are substantially satisfactory according to that participant's individual exchange objectives,

whereby the substantially-satisfactory offered amounts as negotiated through the intermediary determine an exchange of a plurality of commodities among a plurality of participants.--;

–128. (Amended) A computer readable [media comprising] medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 116 when said computer-executable instructions are loaded into said computer.

129. (Twice Amended) A computer implemented method for intermediating electronic [intermediated] exchange of a plurality of commodities among a plurality of participants comprising the steps of:

(a) receiving from the participants

(i) electronic opening messages, which comprise digital data representing opening requests of the participants to buy and/or to sell amounts of one or more commodities, and

(ii) electronic counter-offer messages, which comprise digital data representing further requests of the participants to buy and/or to sell amounts of one or more commodities, with each further request being less than or equal to the amounts represented in the corresponding opening request, and

(b) generating electronic offer messages to the participants,

wherein the offer messages are generated in response to previously received opening messages and/or to previously received counter-offer messages,

wherein electronic offer messages comprise digital data representing respective offers to the participants to buy and/or to sell amounts of one or more commodities corresponding to respective received requests to sell and/or to buy, with each offer being less than or equal to the amounts represented in the corresponding opening request, and

wherein, for at least one commodity, the opening messages and the offer messages comprise requests to buy and requests to sell, and, for each commodity, the total of the amounts offered for sale in all the generated offer messages equals the total of the amounts offered for purchase in all the generated offer messages, and

(c) repeating steps (a) and (b), if necessary, until the last offer message to each participant is indicated in a [further] responsive message from that participant to represent offered amounts of one or more commodities to buy and/or to sell in the exchange that are substantially satisfactory according to that participant's individual exchange objectives,

whereby the substantially-satisfactory offered amounts determine an intermediated exchange of a plurality of commodities among a plurality of participants.--;

--139. (Amended) A computer readable [media comprising] medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 129 when said computer-executable instructions are loaded into said computer.

--140. (Twice Amended) A computer implemented method for representing a participant in an intermediated exchange of commodities with at least one other participant, comprising the steps of:

generating an electronic opening message to an intermediary, wherein the electronic opening message comprises digital data representing an opening request of the participant to buy and/or to sell amounts of one or more commodities;

receiving an electronic offer message from said intermediary to respectively sell and/or buy amounts of one or more commodities in response to said electronic opening message and a corresponding electronic opening message from said at least one other participant; and

generating one or more electronic counter-offer messages to the intermediary in response to said electronic offer message in accordance with the participant's individual exchange objectives,

wherein the electronic counter-offer messages comprise digital data representing (i) further requests to buy and/or to sell amounts of one or more commodities with each further request being less than or equal to the amounts represented in the corresponding opening request, or (ii) an indication that the amounts in a received offer message are substantially satisfactory to the participant,

wherein each counter-offer message is generated in response to an electronic offer message,

wherein an electronic offer message comprises digital data representing offers to the participant to buy and/or to sell amounts of one or more commodities in accordance with objectives of the intermediated exchange, with the offers being less than or equal to the amounts represented in the corresponding opening request, and

whereby the substantially-satisfactory, offered amounts represent each participant's objectives in the intermediated exchange.—;

--147. (Amended) A computer readable [media comprising] medium having stored therein encoded computer-executable instructions for causing a computer to perform the method of claim 140 when said computer-executable instructions are loaded into said computer.—.